

REMARKS

Reconsideration of this application is respectfully requested in view of the foregoing amendment and the following remarks.

Applicants appreciate the acknowledgement of allowable subject matter in claims 2, 3, and 12-14. Applicants appreciate the allowance of claims 16 and 23.

By the foregoing amendment, claims 1, 3, 4, 10, 17, 18, 20 and 22 have been amended, claims 2 and 5 have been cancelled without prejudice or disclaimer for filing in a continuation application, and new claims 24-25 have been added. Thus, claims 1, 3, 4, 6-11 and 12-25 are currently pending in the application, with claims 1, 3, 4, 6-11, 12-15, 17-22 and 24-25 subject to examination.

In the Office Action mailed July 13, 2005, claims 10 and 20 were rejected under 35 U.S.C. § 102(b), as being anticipated by U.S. Patent No. 5,612,733 to Flohr (hereinafter "Flohr"). Claims 10 and 20 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Publication No. 2004/0204194 by Akai (hereinafter "Akai"). Claims 1, 4, 5, 17 and 18 were rejected under 35 U.S.C. § 102(a) as being anticipated by WO 03/065692 to Taneya (hereinafter "Taneya"). Claims 11 and 21 were rejected under 35 U.S.C. § 102(a) as being anticipated by KR2004016477, (hereinafter "Kwon"). Claims 11 and 21 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Publication No. 2004/0137958 to Sawai, (hereinafter "Sawai"). Claims 15 and 22 were rejected under 35 U.S.C. § 102(b) as being anticipated by JP 06-302169 to Murakawa, (hereinafter "Murakawa"). Claims 6-8 and 19 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,961,211 to Tsugane, (hereinafter "Tsugane"). Claim 9 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsugane in

view of U.S. Patent No. 6,714,238 to Urisaka (hereinafter, "Urisaka"). Claims 1, 4, 5, 17 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publication No. 2001/0004269 to Shibata, et al (herein after "Shibata") in view of JP 06-302169 to Murakawa, (hereinafter Murakawa). Claims 16 and 23 were allowed, and claims 2, 3, and 12-14 were objected to for depending from a rejected base claim. It is noted that claims 2, 5 and 11 have been cancelled, and claims 1, 3, 4, 10, 12, 17, 18 and 20-22 have been amended. To the extent the rejections apply to the claims currently pending, the Applicants hereby traverse the rejections, as follows.

The Applicants respectfully submit that the Kwon reference (KR2004016477) and the Sawai reference (U.S. Publication No. 2004/0137958) are not proper prior art references.

KR2004016477 to Kwon has a critical date of February 25, 2004. U.S. Publication No. 2004/0137958 to Sawai has a critical date of December 22, 2003. The subject application has a foreign priority date of March 31, 2003. Thus, the effective U.S. filing date of the subject application predates those of the Kwon and Sawai references. Accordingly, the rejections of claims 11 and 21 based on these references are improper.

Receipt of a certified copy of the priority document, JP 2003-095719, in the subject application was acknowledged by the Office in the outstanding Office Action. In order to perfect priority, submitted herewith is a verified translation of the certified priority document, JP 2003-095719.

Since neither reference cited in the rejections of claims 11 and 21 is proper, the Applicants respectfully submit that claims 11 and 21 are in condition for allowance.

As claim 11 is in condition for allowance, the Applicants submit that claims 12-14, which depend from allowable claim 11, are likewise allowable.

Claims 1, 3, 4, 12-14 and 17-18

Claims 2, 3, and 12-14 were objected to only for depending from a rejected base claim. Claims 1, 4, 17 and 18 have been amended to include the allowable subject matter of claim 2, and claim 2 has been cancelled. Thus, claims 1, 4, 17 and 18 are in condition for allowance. As claim 1 is allowable, claim 3, which depends from claim 1, is similarly allowable for the same reasons as claim 1, as well as for the additional subject matter recited therein.

As noted above, claims 12-14 depend from claim 11, which is allowable. Thus, claims 12-14 are likewise allowable.

Claims 6-8 and 19

Claims 6-8 and 19 were rejected under 35 U.S.C. § 102(b) as being anticipated by Tsugane, and claim 9 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsugane in view of Urisaka.

Claim 6 recites in part:

a selection unit selecting one of said plurality of capture units; and
a control unit controlling said plurality of voice input units based on said selection unit.

Claim 19 recites, in part:

selection means for selecting one of said plurality of capture means; and
control means for controlling said plurality of voice input means based on said selection means.

Tsugane discloses switching the operating mode of a TV camera according to a voice entered into a certain microphone specified among a plurality of provided microphones. Thus, in Tsugane, the voice controls the operation of the TV camera. In contrast, in the claimed invention, a control unit or means controls a plurality of voice input units or means, based on a selected capture unit or means. Thus, in the claimed invention, the selected capture means controls the voice input means. Tsugane neither discloses nor suggests at least the combination of a selection unit (or means) selecting one of said plurality of capture units (or means); and a control unit (or means) controlling said plurality of voice input units (or means) based on said selection unit (or means), as recited in claims 6 and 19. For at least this reason, claims 6 and 19 are patentably distinct over the cited art of record and in condition for allowance.

As claim 6 is allowable, claims 7 and 8, which depend from allowable claim 6, are allowable for the same reasons as claim 6, as well as for the additional subject matter recited therein. Withdrawal of the rejections of claims 6-8 and 19 is respectfully requested.

Similarly to as discussed above with respect to claims 6-8, the Applicants submit that neither Tsugane nor Urisaka, alone or combined, discloses or suggests at least the combination of a selection unit selecting one of said plurality of capture units; and a control unit controlling said plurality of voice input units based on said selection unit, as recited in independent claim 6, from which claim 9 depends. For at least this reason, the Applicants submit that claim 9 is patentably distinct over the cited art of record and in condition for allowance.

Claims 10 and 20

Claims 10 and 20 were rejected under 35 U.S.C. § 102(b), as being anticipated by Flohr and under 35 U.S.C. § 102(e) as being anticipated by Akai (hereinafter “Akai”). The Applicants submit that neither Flohr nor Akai, alone or combined, discloses or suggests at least the features of a voice obtaining unit (or means) obtaining only voices of which input levels exceed a threshold value among the voices input to said voice input units (or means), as recited in claims 10 and 20, as amended.

For at least this reason, the Applicants submit that claims 10 and 20, as amended, are allowable over the cited art of record.

Claims 15 and 22

Claims 15 and 22 were rejected under 35 U.S.C. § 102(b) as being anticipated by Murakawa. Claims 15 and 22, as amended, are directed to a cellular phone apparatus. The Applicants submit that Murakawa neither discloses nor suggests at least the features of a cellular phone apparatus, comprising: capture unit (or means) for capturing a target object; voice input unit (or means) for inputting voice; rotation unit (or means) for rotating said capture unit (or means); and sensitivity control unit (or means) for controlling sensitivity of said voice input unit (or means) based on a rotation angle of said rotation unit (or means), as recited in claims 15 and 22, as amended.

For at least this reason, the Applicants submit that claims 15 and 22, as amended, are allowable over Murakawa.

In addition, with regard to each of the rejections under §103 in the Office Action, it is also respectfully submitted that the Examiner has not yet set forth a *prima facie* case of obviousness. The PTO has the burden under §103 to establish a *prima facie*

case of obviousness. In re Fine, 5 U.S.P.Q.2nd 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. Id. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Lee, 277 F.3d 1338 (Fed. Cir. 2002).

In the Office Action, the Examiner merely states that the motivation for combining the references is found in certain advantages stated by the Examiner (see, e.g., pp. 6-7). The Examiner, however, indicates nothing from within the applied references to evidence the desirability of this combination. This is an insufficient showing of motivation.

New Claims 24-25

The Applicants submit that newly added claim 24 is allowable over the cited art of record at least because none of the cited art of record, or combination thereof, discloses or suggests at least the combination of capture means for capturing a target object; voice input means for inputting voice; and rotation means for rotating said capture

means and said voice input means; and a rotation control means controlling a rotating operation of said rotation means either with a relative position between said capture means and said voice input means maintained or with said capture means and said voice input means independently operated, as recited in claim 24.

The Applicants submit that newly added claim 25 is allowable over the cited art of record at least because none of the cited art of record, or combination thereof, discloses or suggests at least the combination of capture means for capturing a target object; voice input means for inputting voice; and rotation means for rotating said capture means and said voice input means with a relative position between said capture means and said voice input means maintained; and an image rotation means rotating a captured image by $\pm 180^{\circ}$ when a rotation angle from a predetermined position of said rotation means exceeds $\pm 90^{\circ}$, as recited in claim 25.

Conclusion

For all of the above reasons, it is respectfully submitted that the claims now pending patentability distinguish the present invention from the cited references. Accordingly, reconsideration and withdrawal of the outstanding rejections and an issuance of a Notice of Allowance are earnestly solicited.

Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is invited to contact the Applicants' undersigned representative at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of time.

The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment associated with this communication to Deposit Account No. 01-2300 referencing client matter number 101229-00002.

Respectfully submitted,

Arent Fox, PLLC

Michele L. Connell # 37,351
for Michele L. Connell
Registration No. 52,763

Customer No. 004372
1050 Connecticut Ave., N.W.
Suite 400
Washington, D.C. 20036-5339
Telephone No. (202) 857-6104
Facsimile No. (202) 857-6395

CMM/MLC

Enclosures: Petition for Extension of Time
 Verified Translation of JP 2003-095719